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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,501	10/07/2003	Bruce Randall Hamlett	HBR-106-A	9255

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EXAMINER

ALIMENTI, SUSAN C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/614,501

Applicant(s)

HAMLETT, BRUCE RANDALL

Examiner

Susan C. Alimenti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/12/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 13-17 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5-12 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowling (US 6,357,159).

Bowling discloses the invention substantially as claimed. Bowling's animal decoy device comprises a pulley system for hanging/and or pulling a decoy, actuating a motion that mimics that of a real animal. As can be seen in Figures 16, 17 and 32 several animal decoys contact or strike the ground, thus making a noise imitating the sound of the footfall of an animal (Bowling, col.9, lns.15-19). A spring 32 extends along a substantially arcuate path as it winds about shaft 26, and is considered to have a substantially straight path as a whole along the length of shaft 26. The device is remotely engageable by positioning means comprising a plurality of elastic, resilient cords 48, 102, 106 engageable with respect to blunt surface 78, 86 and anchors 64, 66, 104, and 108 (Bowling, Figures 24-27 and 32).

Regarding claims 3, Figures 19-20 show one of the blunt surfaces 78 operable to selectively strike the ground, and said blunt 78 having *substantially* hemispherical side surfaces. Further, Figure 32 shows a deer decoy 86 having feet which variably "strike" the ground surface,

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as described above hanging on elastic cords 48, and are considered to be *substantially* hemispherical.

Bowling's above device is considered to be inherently capable of performing the method of claims 19-20.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-2, 5, 10-12 and 19-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Burrison (US 20030200694 A1).

Burrison discloses a device for imitating the sound of a footfall of an animal in order to attract that animal comprising a means for generating the sound 10 including a blunt defined as the outer casing 16 of the device, for operatively striking against a surface such as the ground. A means for positioning the blunt relative to the ground is defined as the user's hand forcing the blunt to come in contact with the ground.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowling.

Bowling discloses the claimed invention except the blunt surface, i.e. the feet portion of decoy 86, is not positively disclosed as being in the shape of a sphere. By Applicant's own admission, the striking surface of the blunt may take on a variety of shapes (Specification of present application, p.3, lns.15-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the blunt surface in Bowling's device spherical, since it has been held that there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.

#### *Allowable Subject Matter*

7. Claims 13-17 and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

8. Applicant's arguments filed 12 July 2004 have been fully considered but they are not persuasive. In response to Applicant's arguments that Bowling does not disclose the claimed invention because he does not show a blunt surface selectively striking the ground, the examiner respectfully disagrees. The applicant is reminded of the limitations cited in the claims, more specifically the phrase generally of claims 5 and 10, "a blunt *operable* to selectively and vertically strike a surface". Applicant is further reminded that a recitation of the intended use of

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the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the present case, clearly Bowling's decoy 86, hanging from elastic cords 102, 106, is capable of a bobbing motion wherein the feet portion would strike the ground in a vertical motion. Such a bobbing motion could be imposed on the system by wind, or the decoy's own mass intermittently weighing on the elastic cords and causing a wave in the line 102.

The Applicant also contends that the contact that Bowling's decoys have with the ground would not cause a noise imitating the footfall of an animal. The examiner again respectfully disagrees and maintains that any type of ground contact by any object is considered to produce a sound that imitates the footfall of an animal, since this limitation broadly encompasses numerous sounds. TL

In conclusion, for these and the reasons listed in the rejections above, the examiner maintains the rejection of claims 1-12, and 18-20.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Carone can be reached on 703-306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCA

  
TERI PHAM LUU  
PRIMARY EXAMINER